

Remarks

Claims 1- 2, 6-15, 17, 25-31, and 47-72 were pending in the present application as of the mailing of the Office Action. Claims 11-13, 17, 48-50, 53, 63-65 and 67-72 have been cancelled. Claims 73-77 are new.

The Examiner has rejected Claims 1-2, 6-13, 15, 17, 25-31, and 47-50, 52-65, and 67-72 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,893,098 to Peters et al. in view of a publication by Sarchione et al. The Examiner rejected Claims 14, 51 and 66 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,893,098 to Peters et al. in view of a publication by Sarchione et al. and in further view of U.S. Patent No. 3,628,255 to Golden.

Applicant has amended independent Claims 1, 15 and 52. The prior art references cited by the Examiner do not disclose each and every limitation of Claims 1, 15 and 52 and, thus, those claims are allowable. The remaining claims all depend on Claims 1, 15 or 52 and are allowable because Claims 1, 15 and 52 are allowable.

The Examiner's Rejections Under 35 U.S.C. 103(a) Should Be Withdrawn

A. The Office Action Has Not Met the Burden of Establishing a Prima Facie Case of Obviousness With Respect to Independent Claims 1, 15 and 52.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP 2143.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

1. There Is No Suggestion or Motivation To Combine Peters and Sarchione

The Office Action concedes that Peters does not disclose including questions related to life history information, wherein the life history information comprises more than one life event, or that the responses are relevant to predicting a predefined negative outcome for the applicant. Office Action at p. 4. The Office Action states that at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to include the aforementioned components of Sarchione with the method taught by Peters with the motivation of "reducing the amount of time to answer a survey by guiding a user through the survey." Office Action at p. 5.

The Office Action's reasoning is flawed. Contrary the assertion of the Examiner, if a person of ordinary skill in the art at the time of the invention was motivated to reduce the amount of time to answer a survey by guiding a user through the survey," such person would not consider the Sarchione reference. There is nothing in Sarchione that addresses taking a survey, reducing the amount of time to answer a survey or guiding a user through survey. Given the lack of such a disclosure in Sarchione, the only possible motivation or suggestion to combine these references is through impermissible hindsight.

2. Even if Peters and Sarchione Were Properly Combinable, The Office Action Does not Demonstrate a Reasonable Expectation of Success.

The prior art can be modified or combined to reject claims as *prima facie* obvious as long as there is a reasonable expectation of success. MPEP 2143.02; *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Here, given lack of any discussion in Sarchione of surveys, reducing the amount of time to take a survey or guiding a person through a survey, there is not reasonable expectation of successfully combining those approaches. Indeed, the Office Action fails to even assert that there is a reasonable expectation of successfully combining Peters and Sarchione, much less articulate a rationale as to how such a successful combination could be reasonably expected.

C. Claims 14, 51 and 66 Have Been Amended and Are Allowable Over the Cited Prior Art.

With respect to Claims 14, 51 and 66, the Office Action relies on Peters in view of Sarchione in further view of Golden as a basis for rejecting the claims. Claims 14, 51 and 66 have been amended and are now allowable over Peters in view of Sarchione in further view of Golden.

D. Even If the Office Action Met the Burden of Establishing a Prima Facie Case of Obviousness, Which It Has Not, There Is Ample Evidence of Nonobviousness.

Applicants remind the Examiner that ample evidence of nonobviousness has already been submitted in connection with the present application.

Objective evidence or secondary considerations such as unexpected results, commercial success, long-felt need, failure of others, copying by others, licensing, and skepticism of experts are relevant to the issue of obviousness and must be considered in every case in which they are present. MPEP 2141. When evidence of any of these secondary considerations is submitted, the examiner must evaluate the evidence. The weight to be accorded to the evidence depends on the individual factual circumstances of each case. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 USPQ 81 (Fed. Cir. 1986), *cert. denied*, 480 U.S. 947 (1987). The ultimate determination on

patentability is made on the entire record. *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).

Here, the Declarations of James E. Seiber (“Seiber Declaration”), and Ellen B. Cuttler (“Cuttler Declaration”), which have already been submitted, provide ample evidence of nonobviousness.

1. The Claimed Invention Has Yielded Significant, Unexpected Results.

A greater than expected result is an evidentiary factor pertinent to the legal conclusion of obviousness of the claims at issue. MPEP 716.02(a). Applicants may show that the results were greater than those which would have been expected from the prior art to an unobvious extent, and that the results are of a significant, practical advantage. *Id.*, citing, *Ex parte The NutraSweet Co.*, 19 USPQ2d 1586 (Bd. Pat. App. & Inter. 1991).

Whether the unexpected results are the result of unexpectedly improved results or a property not taught by the prior art, the objective evidence of nonobviousness must be commensurate in scope with the claims which the evidence is offered to support. MPEP 716.02(a).

Here, the Seiber Declaration provides evidence of significant, practical, unexpected results flowing from the claimed invention. Mr. Seiber is the Executive Director of the Illinois State Police Merit Board and is responsible for recruiting and selecting applicants for employment as Troopers with the Illinois State Police. Seiber Declaration at ¶1. The Illinois State Police Merit Board has been a client of Applicant Law Enforcement Services, Inc. since 1992. *Id.* at ¶ 2. Mr. Seiber is familiar with Applicant’s ONLINE PHQ product and is also familiar with the usage and availability of employment applicant screening instruments in the law enforcement field. *Id.* at ¶ 3.

As detailed in the Seiber Declaration, prior to the introduction the employment screening instrument of the present invention in March 2000, the Illinois State Police used polygraph tests to screen out applicants for employment because the veracity of the life history information obtained by conventional techniques, was so low. Seiber Declaration at ¶ 4. The Illinois State Police Merit Board began Applicant's ONLINE PHQ product in approximately March 2000. Id. at ¶ 5.

The Illinois State Police Merit Board used Applicant's ONLINE PHQ product for a single selection cycle, and the increased veracity of the life history information obtained via the ONLINE PHQ product made routine use of polygraph examinations for law enforcement employment applicants unnecessary. Id. at ¶ 6. Mr. Seiber declares that he expected that obtaining life history information using a computerized system would be a more efficient method of obtaining such information than obtaining such information manually, and that products, such as the ONLINE PHQ, which use stem questions and revealed branch questions, wherein the answer to the stem question cannot be changed by the applicant after the branch questions is revealed, would result in more truthful life history information. Id. at ¶ 7. However, Mr. Seiber also declares that the ONLINE PHQ product resulted in applicants for employment providing significantly more truthful life history information than he expected. Id. Indeed, Mr. Seiber declares that while he expected that the Illinois State Police Merit Board would experience a degree of increase in the veracity of the life history information by using a product such as the ONLINE PHQ, he did not expect that the Illinois State Police would be able to substantially eliminate routine use of polygraph tests in connection with screening applicants for law enforcement employment. Id at ¶ 9. Since March 2000, the Illinois State Police has required all

applicants for employment (approximately 2000) to provide background information via the ONLINE PHQ product. Id. at ¶ 10.

Importantly, the Seiber Declaration makes clear that the significant, unexpected results experienced by the Illinois State Police Merit flowed from the claimed features of the invention:

11. The Illinois State Police is making such extensive and widespread use of LESI's ONLINE PHQ product because it provides significantly more truthful life information for law enforcement employment applicants. The product provides more truthful information because stem questions are presented and the branch question is revealed only after the applicant answers the related stem questions. Thus, the applicant is unlikely to discern a relationship between the stem question and the later revealed branch question and is more likely to provide truthful information to the revealed branch question and/or is less likely to provide a positively biased response.

12. In addition, even if an applicant is able to discern the relationship between a stem question and a later revealed branch question, the ONLINE PHQ product electronically "locks" the answer to the stem question, so that the applicant is unable to change the response to the stem question after the branch question is revealed.

Seiber Declaration at ¶¶ 11-12.

In summary, the evidence submitted provides evidence of significant, unexpected practical results flowing from the claimed features of the invention. Such evidence of nonobviousness should result in the allowance of the pending claims, even if the Office Action had established a prima facie case of obviousness, which it has not.

2. The ONLINE PHQ Product Has Been Commercially Successful Because of the Claimed Features of the Invention.

An applicant who is asserting commercial success to support its contention of nonobviousness bears the burden of proof of establishing a nexus between the claimed invention

and evidence of commercial success. MPEP 716.03. The Federal Circuit has acknowledged that applicant bears the burden of establishing nexus, stating:

In the *ex parte* process of examining a patent application, however, the PTO lacks the means or resources to gather evidence which supports or refutes the applicant's assertion that the sale constitute commercial success. *C.f. Ex parte Remark*, 15 USPQ2d 1498, 1503 (Bd. Pat. App. & Int. 1990)(evidentiary routine of shifting burdens in civil proceedings inappropriate in *ex parte* prosecution proceedings because examiner has no available means for adducing evidence). Consequently, the PTO must rely upon the applicant to provide hard evidence of commercial success.

Objective evidence of nonobviousness, including, commercial success, must be commensurate in scope with the claims. MPEP 716.03(a).

The Seiber and Cuttler Declarations provide evidence of commercial success and a nexus between the commercial success and the evidence of commercial success. The Cuttler Declaration provides evidence of substantial increases in gross revenues, over time, from the ONLINE PHQ product. Specifically, the ONLINE PHQ product was introduced in 2000, generating gross sales of \$6225 based on 145 units.¹ Cuttler Declaration at ¶ 5. In the most recent calendar year, gross sales were \$147,117 based on sales of 3525 units. *Id.* As can be appreciated, such sales increases are highly probative of the commercial success of the ONLINE PHQ product.

As indicated in the Seiber Declaration, there is a clear connection between the commercial success of the ONLINE PHQ product and the features of the claimed invention. Specifically, the Seiber Declaration states that the ONLINE PHQ product provides more truthful information because the branch question is revealed only after the applicant answers the related stem questions. Thus, the applicant is unlikely to discern a relationship between the stem

¹ A "unit" represents an employment applicant that provides life history information via the ONLINE PHQ product. Cuttler Declaration at ¶ 6.

question and the later revealed branch question and is more likely to provide truthful information to the revealed branch question and/or is less likely to provide a positively biased response. Seiber Declaration at ¶ 11. In addition, the Seiber Declaration states that even if an applicant is able to discern the relationship between a stem question and a later revealed branch question, the ONLINE PHQ product electronically “locks” the answer to the stem question, so that the applicant is unable to change the response to the stem question after the branch question is revealed. Seiber Declaration at ¶ 12.

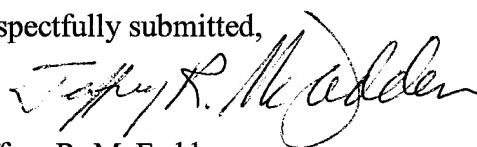
As indicated by the Cuttler Declaration, from 2000-2003, Applicant expended a mere \$20,486 on advertising and promotion of the ONLINE PHQ product through trade shows and direct mail advertising. Cuttler Declaration ¶ 7. Applicant has not expended any money on print, radio or television advertising. Id. Indeed, customers typically learn of the ONLINE PHQ product from word-of-mouth “advertising.” Id. In addition, LESI has no dedicated sales personnel for the ONLINE PHQ product, the sales functions being performed by Ellen Cuttler, who is also the President of LESI. Cuttler Declaration at ¶ 8. Thus, the commercial success if the claimed invention cannot be attributed to advertising and promotion.

In summary, the evidence submitted provides evidence of significant commercial success of the claimed invention and evidence of a clear connection between such commercial success and the claimed features of the invention. Such evidence of nonobviousness should result in the allowance of the pending claims, even if the Office Action had established a prima facie case of obviousness, which it has not.

Conclusion

Applicant believes that this case is now in condition for an immediate allowance of Claims 1- 2, 6-10, 14-15, 25-31, 47, 51-52, 54-62, 66 and 73-77, and such action is respectfully requested. If any issue remains unresolved, Applicant's counsel would appreciate the opportunity for a telephone interview to expedite allowance.

Respectfully submitted,



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Date: April 17, 2006
File No.: 4590-004 (4.5)